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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,515	04/09/2001	Richard L. Schwartz	SMIO.0100001	6719

7590

06/16/2004

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EXAMINER

GAUTHIER, GERALD

ART UNIT	PAPER NUMBER
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2645

18

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/829,515

**Applicant(s)**

SCHWARTZ ET AL.

**Examiner**

Gerald Gauthier

**Art Unit**

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 33,35,37,38,40,42,43 and 71-95 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 42,43 and 92-95 is/are allowed.
- 6) ☒ Claim(s) 33,35,38,40,74,76-78,80,81,85,87-89 and 91 is/are rejected.
- 7) ☒ Claim(s) 37,71-73,75,79,82-84,86 and 90 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>17</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 7, 2004 has been entered.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 33, 38, 40, 74, 76-78, 80-81, 85, 87-89 and 91** are rejected under 35 U.S.C. 102(e) as being anticipated by Bull et al. (US 6,498,841).

Regarding **claim 33**, Bull discloses a method for facilitating mediated virtual communication (column 1, lines 14-16), comprising:

receiving, by a mediation system (200 on FIG. 2), a request for voice-based communication (column 6, line 12 “a current call”) from a communication device of a calling party (220 on FIG. 2), wherein the request for voice-based communication requests commencement of a telephone call (column 6, line 12 “a current call”) between the communication device of the calling party and a communication device of a called party (column 6, lines 12-16) [The system 200 receives a call from the calling telephone station 220 to a called telephone station 222];

automatically evaluating, by the mediation system, contextual information (column 6, line 21 “a calling party identification parameter”) associated with the telephone call, in response to receiving the request for voice-based communication (column 6, lines 17-33) [The SSP 202 activates a attempt trigger and generates a query to the SCP 206, the query the telephone number of the calling party];

automatically preparing, by the mediation system, a list of follow-through options (column 7, lines 41-42), based on the contextual information (column 7, lines 20-54) [The SN/IP 212 examines the telephone number associated with the calling station an identifies information corresponding to the telephone number];

automatically transmitting a message (column 9, line 8 “a message”) from the mediation system to the communication device of the called party, wherein the message includes the list of follow-through options (column 9, line 13 “audible instructions”) to be displayed on the communication device (column 10, line 44 “the display”) of the called

party for selection by the called party (column 9, lines 7-35 and column 10, lines 34-45)

[The system determines the type of equipment at the called party station and sends instructions for call dispositions to be displayed at the called party station CPE];

receiving, by the mediation system, a response (column 9, line 19 "press 2 to deny the call") from the communication device of the called party, one of the follow-through options (column 9, line 19 "press 2 to deny the call") as having been selected by the called party (column 9, lines 7-35) [The called party is provided with call dispositions options to suit the need and the system will answer accordingly]; and

facilitating a mediated follow-through operation (column 9, line 38 "connect the call, cancel the call") based on the selected one of the follow-through options (column 9, lines 36-42) [The system in response to input provided by the called party can connect the call, cancel the call].

Regarding **claim 38**, Bull discloses determining a present availability status for the called party (column 7, lines 61-67).

Regarding **claim 40**, Bull discloses determining an availability status for the calling party (column 7, lines 61-67).

Regarding **claims 74 and 85**, Bull discloses automatically preparing a communication summary in response to receiving the request for voice-based communication from the communication device of the calling party, wherein the

communication summary includes identifying information for the calling party (column 9, lines 7-35); and

transmitting the communication summary from the mediation system to the communication device of the called party (column 9, lines 7-35).

Regarding **claims 76 and 87**, Bull discloses tracking responses from the called party to multiple communication requests, to identify a recurring response from the called party (column 9, lines 7-35); and

automatically handling a subsequent telephone call to the communication device of the called party on behalf of the called party, in accordance with the recurring response, without receiving input from the called party pertaining to the subsequent call (column 2, lines 7-35).

Regarding **claims 77 and 88**, Bull discloses receiving input from the called party specifying a default option for mediating incoming calls for the called party (column 9, lines 7-35); and

automatically mediating an incoming call to the communication device of the called party on behalf of the called party, in accordance with the default option, without receiving input from the called party pertaining specifically to that incoming call (column 9, lines 7-35).

Regarding **claims 78 and 89**, Bull discloses automatically providing instructions to a person that originated the incoming call, wherein the instructions pertain to leaving voice mail for the called party (column 9, lines 7-35).

Regarding **claims 80 and 91**, Bull discloses automatically interacting with a person that originated the incoming call, on behalf of the called party, to schedule a follow-up call (column 9, lines 36-42).

Regarding **claim 81**, Bull discloses all limitations of **claim 81** as stated in **claim 33** above and furthermore Bull discloses a computer-usable medium (110 on FIG. 1); and computer instructions (110, 112 on FIG. 1).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. **Claim 35** is rejected under 35 U.S.C. 103(a) as being unpatentable over Bull in view of Lim et al. (US 6,477,240).

Regarding **claim 35**, Bull as applied to claim 33 above differs from claim 35 in that it fails to disclose updating a data set in a mediation subscriber profile for the called party in response to receiving the response identifying the selected one of the follow-through options.

However, Lim teaches updating a data set in a mediation subscriber profile for the called party in response to receiving the response identifying the selected one of the follow-through options (column 7, lines 29-60).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use the telephony server of Lim in the service node of Bull.

The modification of the invention would offer the capability of automatically update the data set of the subscriber's profile such as the system would create and end-to-end connection to facilitate the subscriber of the unified messaging system.



***Allowable Subject Matter***

6. **Claims 37, 71-73, 75, 79, 82-84, 86 and 90** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter:

Regarding **claim 37**, the prior art of record at this time fails to disclose, archiving identifying information of the calling party; archiving an availability status of the called party during a mediation process for the request for voice-based communication and archiving information about the follow-through option selected by the called party during the mediation process.

Regarding **claims 71 and 82**, the prior art of record at this time fails to disclose the selected follow-through action comprises an option to automatically notify the calling party that the called party plans to call the calling party back later and the operation of facilitating a mediated follow-through operation based on the selected one of the follow-through options comprises automatically notifying the calling party that the called party plans to call the calling party back later.

Regarding **claims 75 and 86**, the prior art of record at this time fails to disclose the communication summary sent to the communication device of the called party

comprises information about previous attempts by the calling party to call the called party.

Regarding **claims 79 and 90**, the prior art of record at this time fails to disclose automatically mediating the incoming call in accordance with a behavior-specific follow-through action.

8. **Claims 42-43 and 92-95** are allowed.
9. The following is a statement of reasons for the indication of allowable subject matter:

Regarding **claims 92 and 94**, the prior art of record at this time fails to disclose automatically calling a communication device of a second person on behalf of the user, in response to receiving the response from the communication device of the user.

### ***Response to Arguments***

10. Applicant's arguments filed on May 7, 2004 have been fully considered but they are not persuasive.

The applicant stated on page 11, ¶ 2 that Bull fails to disclose automatically transmitting a message from the mediation system to the communication device of the called party.

The examiner respectfully disagrees.

Bull (column 9 and column 10) that the system transmits a message to the called party depends on the called party equipment of dispositions of the call. The message reads on these instructions find in Bull.

**Conclusion**

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (703) 305-0981. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**GERALD GAUTHIER**  
**PATENT EXAMINER**

g.g.

June 13, 2004

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